

Patent
Attorney Docket: WHIT/0002.A

REMARKS

Applicant acknowledges and thanks the examiner for the withdrawal of rejections to the drawings under 37 CFR 1.83(a) and to claim 36 under 35 U.S.C. 112, second paragraph.

The Final Office Action mailed on July 26, 2005 appears to have maintained all of anticipation and obviousness rejections of the previous action. Therefore, I wish to reply to the Examiner's "Response to Arguments."

Claims must be interpreted consistent with the specification.

The previous response filed by the Applicant set out certain arguments and also pointed to evidence from the Applicant's specification regarding the meaning of certain important claims terms. Applicant believes that the Court of Appeals for the Federal Circuit has recently reaffirmed that examiners must interpret claim terms in a manner that is consistent with the specification. The case of *In re American Academy of Science Tech. Center* is cited in the Manual of Patent Examining Procedure, Section 211.01 entitled "Plain Meaning." According to this Federal Circuit opinion, "[d]uring examination, 'claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *In re American Academy of Science Tech Center*, 367 F.3d 1359 (Fed. Cir. 2004). Accordingly, it is required that claim terms be read in light of the specification and interpreted consistent with the specification. The M.P.E.P. Section 2111.01, Subsection III, entitled "Applicant May Be Own Lexicographer," emphasizes that:

The specification should also be relied on for more than just explicit lexicography or clear disavowal of claim scope to determine the meaning of a claim term when applicant acts as his or her own lexicographer; the meaning of a particular claim term may be defined by implication, that is, according to the usage of the term in context in the specification. See *Phillips v. AWH Corp.*, 363 F.3d 1207, 75 USPQ2d 1321 (Fed. Cir. 2005)(*en banc*); and *Vitronicx Corp. v. Conceptronic Inc.*, 90 F.3d 1576,

Patent
Attorney Docket: WHIT/0002.A

1583 USPQ2d 1573, 1577 (Fed. Cir. 1996).

Therefore, Applicant asserts that it is necessary to review the Applicant's specification for express or implied definitions of the claim terms "root-tip-trapping" and "sidewall."

Interpretation of the claim term "root-tip-trapping."

Regarding the proper scope of the term "root-tip-trapping," Applicant asserts that this term is defined by the following:

- (1) "Whitcomb (4,497,132) teaches that when root tips are trapped . . . and cannot extend, root tips cease to grow and root branching results." Specification, para. 5.
- (2) "As a result of root tips 34 becoming trapped, the root tips 34 swell somewhat, become more thick-bodied, give up control and allow side branches 31 to grow." Specification, para. 41.
- (3) "Figure 6 is a partial cross-sectional view of the sidewall 17 in the root-tip-trapping region 13 of the container 10 (similar to Figure 3) illustrating how the tips 34 of the roots 30 enter into the layer of porous fabric 18 and impinge upon the root-impenetrable material 16 to become trapped. As in Figure 4, it is an important effect of the invention that the root tips 34 swell and allow enhanced root side branches 31 to grow within the growth medium 32." Specification, para. 43 and Figure 6.

Accordingly, "root-tip-trapping" means that the tip of a root becomes trapped and cannot grow or extend any further. Furthermore, this definition from the specification is entirely consistent with the ordinary and customary meaning given to the term by those of ordinary skill in the art. Evidence of this fact is found in the cited reference to Reiger, U.S. 6,202,348. Reiger explains that "the nursery industry utilizes three methods to stop root circling and to root prune." Reiger, col. 2, lines 45-46. The third method uses a root pruning structure where "[r]oot tips of plants grown in such pots may

Patent
Attorney Docket: WHIT/0002.A

be trapped . . . so that the roots lose their apical dominance and begin to branch in the pot.” Reiger, col. 2, lines 58-65.

Furthermore, Whitcomb (U.S. Patent 4,442,628) describes a “root-pruning structure” including “root traps” whereby “the tip of the roots” becomes trapped. (U.S. 4,442,628, col. 4, lines 44-64). Root tips become trapped in the ‘628 stair stepped container structure such that physical restriction to further elongation of the root caused branching to occur much like air-root-pruning.

Applicant asserts that this evidence shows that one of ordinary skill in the nursery industry would understand the term “root-tip-trapping” to mean a root pruning method in which root tips are trapped. Thus, a root tip is not “trapped” and a material is not “root-tip-trapping,” as those terms are properly interpreted from the present specification, if the root tip continues to extend and grow in the manner that it does in Reynolds, where the roots grow in the interface between the skin and pot. Reynolds merely redirects root tips in a manner similar to what occurs with other conventional nursery plant containers having smooth side walls.

Interpretation of the claim term “sidewall.”

The present specification consistently distinguishes between a “sidewall” and a “bottom.” For example, in reference to Figure 2, the specification says that “Seams 19 are shown coupling a floor or bottom 15 to the sidewalls 17 of the barrier to form the container 10.” Specification, para. 39; and Figure 2. Accordingly, the Applicant asserts that the specification expressly or impliedly defines a sidewall as being distinct from a bottom or bottom wall. One of ordinary skill in the nursery industry, after reading the specification and seeing that the specification distinguishes a “sidewall” from a “bottom”, would understand that the “sidewall” does not include the “bottom.”

Patent
Attorney Docket: WHIT/0002.A

Furthermore, this definition is consistent with the ordinary and customary meaning given this term in the art. Even the references cited by the examiner make a similar distinction between a "side wall" and a "bottom wall." For example, Reynolds (U.S. 3,080,680) discloses that his enrobement comprises "a portion 61 which is adherent to the bottom wall 17 of the port and portions 62 which are smoothly adherent to the side walls 16 of the pot. (See Figure 3). As another example, Reiger (U.S. 6,202,348) discloses a pot having "a side wall 142 which is preferably slightly tapered from top to bottom, and a bottom 144." (See Figure 8 for element 142, and Figure 9 for element 144).

Accordingly, Applicant asserts that the term "sidewall" must be interpreted in a manner consistent with the present specification, as well as the cited prior art, as excluding a "bottom." The Examiner has made the unsupported assertion that "a bottom sidewall is also a term known in the art too." (Office Action, page 11, lines 6-7). Regardless of whether this assertion is true or not, the Examiner has produced no evidence supporting this position and this is not the terminology that has been used and defined in the present specification or the two cited prior art references discussed.

Response to the outstanding rejections.

Claims 1-4, 7, 11, 12, 20, 26, 27, 37-40, 46 stand rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds et al. (US 3080680). Applicant respectfully reasserts the remarks made in the previous response regarding this rejection and incorporates the remarks made above with regard to interpreting claim terms consistent with the specification. It is asserted that, when the claims are interpreted in light of the specification, Reynolds does not disclose a "sidewall for a plant container, comprising a substantially water-impermeable root-tip-trapping region and a porous air-root-pruning region adjacent the root-tip-trapping region." (Claim 1). Withdrawal of the rejection is requested.

Claims 5, 6, 8, 9, 14-16, 24, 32, 33, 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above). Applicant respectfully reasserts the remarks made in the previous response regarding this rejection and incorporates the remarks made above with regard to

Patent
Attorney Docket: WHIT/0002.A

interpreting claim terms consistent with the specification. It is asserted that, when the claims are interpreted in light of the specification, Reynolds does not teach, show or suggest a "sidewall for a plant container, comprising a substantially water-impermeable root-tip-trapping region and a porous air-root-pruning region adjacent the root-tip-trapping region." (Claim 1). Withdrawal of the rejection is requested.

Claims 10, 13, 17-19, 47-50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Reiger (US 6202348). Applicant respectfully reasserts the remarks made in the previous response regarding this rejection and incorporates the remarks made above with regard to interpreting claim terms consistent with the specification. It is asserted that, when the claims are interpreted in light of the specification, Reynolds and/or Reiger do not teach, show or suggest a "sidewall for a plant container, comprising a substantially water-impermeable root-tip-trapping region and a porous air-root-pruning region adjacent the root-tip-trapping region." (Claim 1).

It is also asserted that in order to combine Reynolds and Reiger, there must some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined the references. The only motivation being asserted is that "Reynolds et al. discuss in col. 6, lines 65-75, regarding roots trapping." However, Applicant has shown that Reynolds does not in fact disclose "root-tip-trapping" as that term is properly interpreted in light of the specification. Accordingly, the combination of references cannot be supported. Withdrawal of the rejection is requested.

The following group of rejections will be dealt with collectively:

- (1) Claim 21 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Thomas (US 5311700).
- (2) Claims 22, 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Berlitz et al. (GB 2073567).

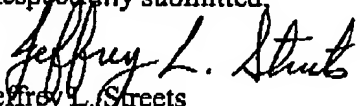
Patent
Attorney Docket: WHIT/0002.A

- (3) Claims 25, 29, 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Van der Goorbergh (EP 300578A3).
- (4) Claims 28, 34, 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. (as above) in view of Flasch, Jr. (US 5852896).
- (5) Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. as modified by Berlitz et al. as applied to claims 1, 3, 22 above, and further in view of Flasch (as above).

Claims 21-23, 25, 28-31 and 34-35 are each ultimately dependent from claim 1. Having addressed the rejections made against claim 1, Applicant respectfully reasserts the remarks made in the previous response regarding these specific rejections and incorporates the remarks made above with regard to interpreting claim terms consistent with the specification. It is asserted that, when the claims are interpreted in light of the specification, there is no combination of references that teach, show or suggest a "sidewall for a plant container, comprising a substantially water-impermeable root-tip-trapping region and a porous air-root-pruning region adjacent the root-tip-trapping region." (Claim 1). Reconsideration and withdrawal of these rejections is requested.

In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/WHIT/0002.A of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,


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